

REMARKS

Claims 22-39, 41, 42, 55, 57-59 and 61-63 are pending in this application. By this Amendment, claims 22, 24-28, 41, 55 and 57 are amended; and claim 40 is canceled without prejudice to or disclaimer of the subject matter contained therein. No new matter is added. Reconsideration and allowance of this application are respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 22-30, 36-42, 55 and 57-59 are rejected under 35 U.S.C. § 102(a) as being anticipated by Mori, (U.S. Patent Publication 2002/0065113) in view of Linge, (U.S. Patent Publication 2002/0028698). This rejection is respectfully traversed.

Applicants submit that Mori and Linge, individually or in combination, fail to disclose and suggest a mobile handset, comprising *at least* “a plurality of loudspeakers being adapted to generate stereo audio signals” and “an image compensation unit so as to allow the mobile handset to be applied in near-to-the-eye applications”, as recited in claim 22.

The Examiner admits that Mori does not disclose “an image compensation unit so as to allow the mobile handset to be applied in near-to-the-eye applications”¹, as recited in claim 22. However, the Examiner attempts to overcome the admitted deficiency of Mori by arguing that Linge teaches the “image compensation unit for near-to-the-eye applications”. Applicants traverse the rejection for at least the following reasons.

Applicants submit that Mori and Linge are not combinable, and the Examiner has failed to provide a proper evidence of a suggestion or motivation for combining Mori and Linge. Further, Applicants submit that the reasoning behind the Examiner’s motivation for combining Mori and Linge is *impermissible hindsight* reconstruction to reject the claims, which is not acceptable.

The Examiner alleged:

[i]t would have been obvious to an artisan of ordinary skill in the art at the time of the invention was made to compensate by magnifying the image in Mori system, as evidenced by Linge, in order to deliver a high resolution visual display for assisting user to read text messages easily.²

It is submitted that the Examiner has failed to provide any evidence or motivation why the microdisplay and magnifying system of Linge would be used in the display of Mori, or more specifically evidence as to why one of ordinary skill in the art would be motivated to modify the

¹ See Office Action, page 3, third paragraph.

display of Mori which uses a display cover as a loudspeaker diaphragm (in which the display should be as large as possible), and Linge uses a magnifying system to provide a high resolution microdisplay (e.g., Mori requires the display to be relatively large whereas Linge requires the display to be relatively small). Thus, the combination of references would at least destroy or change the principle of operation.

Further, the shortcoming of Linge must be supplemented by some other teaching wherein one of ordinary skill in the art must be motivated to provide the supplemental teaching by some motivation, teaching or suggestion of the desirability to make the combination as indicated in *In re Dembizek*, 50 USPQ2d 1646 (Fed. Cir. 1999) and *In re Kotzab*, 55 USPQ 1313 (Fed. Cir. 2000).

Moreover, the Examiner is using impermissible hindsight reconstruction to reject the features recited in claim 22. That is, the Examiner's alleged statement noted above, concludes that the microdisplay disclosed in Linge could be used in Mori, and thus sufficient evidence that Mori and Linge are combinable. Applicants disagree with the Examiner's reasoning, and submit that the mere possibility that one element in a reference could be used in another is not sufficient evidence of a suggestion or motivation to combine the two references. In fact, the Examiner's broad conclusory statement (e.g., "to deliver a high resolution visual display for assisting user to read text messages easily") is wholly misplaced.

Applicants submit that the Examiner has used the present application as a blueprint, selected a prior art in Mori as the main structure device, and then searched other prior art for the missing feature (e.g., image compensation unit to allow the mobile handset to be applied in near-to-the-eye applications), without identifying or discussing any specific evidence or motivation to combine, other than providing broad conclusory statements regarding the knowledge in the art, motivation and obviousness. The Examiner's motivation to combine is not proper. The Federal Circuit has noted that the PTO and the courts can not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ2d 1780 (Fed. Cir. 1988), and that the best defense against hindsight base obviousness is the rigorous application of the requirement for showing of a teaching or a motivation to combine the prior art references. Applicants submit that the Examiner has failed to provide any evidence of motivation for combining the teachings of Mori and Linge.

Even assuming *arguendo* that the teachings of Mori and Linge were combinable, which Applicants do not agree or admit to, it is submitted that the combination of the references fails to

² See Office Action page 3, fourth full paragraph.

teach all of the claimed invention as recited in claim 22. In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), all of the limitations of the rejected claim must be disclosed in the references.

Specifically, Applicants submit that Mori and Linge, individually or in combination, fail to disclose and suggest “a plurality of loudspeakers being adapted to generate stereo audio signals”, as recited in claim 22. Instead, Mori discloses a mobile handset with a loudspeaker functioning by vibrating a cover in front of an LCD display. Accordingly, because the space normally occupied by a loudspeaker opening in the front of a mobile handset can be avoided, the front can include a larger display without increasing its outer dimensions (optionally Mori disclose (see e.g. claims 9 and 10) that two drivers can be used). Accordingly, there is no mentioning of stereo audio signals.

For at least reasons, claim 22 is allowable. Claim 55 is also allowable for reasons similar to those discussed above with regard to claim 22. Specifically, Mori fails to disclose “an image compensation unit so as to allow the display and audio assembly to be applied in near-to-the-eye applications”. Claims 23-50, 36-42, and 57-59 are allowable by virtue of their dependency on either independent claims 22 or 55, and for the features recited therein. Withdrawal of the rejection is respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 10, 31, 48 and 60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori in view of Saiki, et al. (“Saiki”), US Patent Publication 2003/0003945. This rejection is respectfully traversed.

Foremost, claims 10, 48 and 60 have been rendered moot as these claims have been canceled.

With regard to claim 31, as discussed above, Mori neither discloses nor suggests the claimed invention as found in claim 21, the independent claim from which the dependent claim depends. Further, Saiki fails to overcome the noted deficiency of Mori. Namely, Saiki fails to disclose or suggest “an image compensation unit applied in near-to-the-eye applications.” Withdrawal of the rejection is respectfully requested.

Claims 11-14, 32-35, 49-50 and 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mori in view of Smethers, US Patent 6,463,304. This rejection is respectfully traversed.

As discussed above, claims 11-14 and 49-51 have been rendered moot as these claims have been canceled.

With regard to claims 32-35 and 61-63, Applicants submit that Mori fails to disclose or suggest the claimed invention as found in independent claims 22 and 55, the independent claims from which the rejected claims depend. Further, Smethers fails to overcome any deficiency of Mori. Withdrawal of the rejection is respectfully requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 22-39, 41, 42, 55, 57-59, and 61-63 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John Castellano at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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By: _____

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